



UNITED STATES DEPARTMENT OF COMMERCE
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 08/488,164 | 06/07/95 | KOPCHICK | J 7707-015 |

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EXAMINER

SAQUD, C

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1647

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DATE MAILED: 10/24/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/488,164

Applicant(s)
KOPCHICK et al.

Examiner
Christine Saoud

Group Art Unit
1647



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 10-45, 62, 63, and 65-74 is/are pending in the application.

Of the above, claim(s) 45 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 10-44, 62, 63, and 65-74 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Supplemental Office Action

Applicant's responses filed 28 July and 28 August 2000 have been received. Upon review of the response of 28 July 2000, it was noted that a typographical error occurred in the previous Office action. Applicant alleges at page 11 that "[t]he Examiner failed to examine 63 because it is dependent on a cancelled claim." This statement is incorrect. Applicant is directed to page 13, paragraph 2 of Paper #23 which clearly indicates that "[c]laim 63 is a method which depends from claim 46, which is canceled. Because there are no other method claims in the instant application, it is not clear what this claim encompasses. Therefore, the claim is indefinite and cannot be examined with regard to enablement, written description, or art issues." Because the claim held to be indefinite, it was clearly rejected as such which is a rejection under 35 U.S.C. 112/2nd paragraph. It is noted that claim 63 was not included in statement of rejection at page 12, item #9. Therefore, this Supplemental Office action has been prepared.

In addition to all of the rejections made in paper #23, claim 63 is also rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reasons of record in paper #23, restated above.

Applicant's statements regarding the propriety of a final Office action at page 11 have necessitated this Office action. Applicant should note that denial of an interview is not sufficient for alleging that an Office action should not be made final. Applicant is correct in stating that interview⁵ are ordinarily granted in continuing applications, however, granting of an interview is at

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the discretion of the Examiner. The Examiner did not feel that an interview at the time it was requested would "result in expediting the case to a final action". In fact, it would appear from Applicant's response on 28 July 2000, which was after the interview of June 13, 2000, that most, if not all, of the rejections which were made in the case will stand, many more rejections will be added, and a restriction requirement has been necessitated. Addressing the claim amendments filed 28 July 2000 would be premature at this time due to the Supplemental response provided above. As an additional note, the Examiner of record was preparing to go out on maternity leave at the time the request for interview was filed. The Examiner contacted her supervisor who indicated that it would be proper to deny the interview, especially in light of the fact that a response to the previous Office action had been filed and because an Office action was due in the case. It was suggested to Applicant to request the interview via telephone of the Examiner or the Examiner's supervisor. Applicant failed to phone the Examiner or the Examiner's supervisor, but instead contacted the Biotechnology Practice Specialist approximately 5 months after the Office action was mailed.

In terms of clarity of Applicant's response, Applicant should note that amending the claims in a non-sequential manner is very confusing. For example, Applicant begins by amending claims 10, 29, 35 and 46 then proceeds to amend claims 26, 34 then 30-32, etc. Applicant may want to consider presenting the claims to be amended in a logical order, i.e. by presenting the lowest number claim first and ending with the highest number claim, ending with the addition of any new claims. Next, Applicant should address where the support for any new claim limitations may be found in the specification. Then finally, Applicant should address the rejections of record

in the order in which they were presented in the previous Office action. Following these basic guidelines would assist the Examiner in providing a clear and concise Office action in response to Applicant's amendment. Finally, in situations where there are several versions of claims and several claim amendments (as in the instant application), Applicant may wish to conclude with an appendix of the pending claims.

Applicant should note that it would appear that the next Office action could be properly be made final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine Saoud, Ph.D., whose telephone number is (703) 305-7519. The examiner can normally be reached on Monday to Friday from 7AM to 3PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers.

Official papers filed by fax should be directed to (703) 308-4556. If this number is out of service, please call the Group receptionist for an alternate number. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. Official papers should NOT be faxed to 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

October 23, 2000

CHRISTINE SAOUD
PATENT EXAMINER

Christine Saoud